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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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Applicant(s) : Michael GILGE  
Serial No. : 10/541,283  
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For : METHOD FOR RECORDING VIDEO/AUDIO DATA IN A NETWORK  
  
Art Unit : 2621  
Examiner : Marc A. DAZENSKI  
Confirmation No. : 7697

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**APPELLANT'S REPLY BRIEF**  
**UNDER 37 C.F.R. § 41.41**

S I R :

This Reply Brief is being submitted by Applicant in response to the Examiner's Answer mailed on October 27, 2010, and in support of the Notice of Appeal mailed on March 25, 2010, appealing from the Final Office Action dated November 10, 2009, in which claims 37-72 of the above-identified application were finally rejected.

## ARGUMENTS

### **A. Rejection of Claims 37-48, 64-66 and 68-72 under 35 U.S.C. § 103(a)**

Claims 37-48, 64-66 and 68-72 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,386,872 (“Shimizu”) in view of U.S. Patent No. 6,741,977 (“Nagaya”). Applicant respectfully submits that the rejection should be withdrawn for at least the following reasons.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. M.P.E.P. §2143. In addition, as clearly indicated by the Supreme Court, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to [modify] the [prior art] elements” in the manner claimed. See KSR Int’l Co. v. Teleflex, Inc., 82 U.S.P.Q.2d 1385 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” Id., at 1396. To the extent that the Examiner may be relying on the doctrine of inherent disclosure in support of the obviousness rejection, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Claim 37 recites, in relevant parts, “exchanging data between the data memory of the capturing device and the at least one recording device, whereby a virtual data memory is formed for the capturing device by operational association between the data memory of the capturing device and the at least one recording device; at the capturing device,

receiving a request from a user to access the exchanged data, wherein the request does not differentiate between data stored on the data memory of the capturing device and data stored on the virtual data memory; and responsive to the request, retrieving the exchanged data stored on the virtual data memory, the retrieving occurring at the capturing device.” Claims 64 and 72 recite features substantially similar to the above-recited features of claim 37.

In the Appeal Brief, Applicant noted that “the Examiner’s interpretation of the prior art and the claimed elements is not at all clear, particularly since the Examiner does not provide any specific equivalence between each claimed element and a corresponding element of the prior art,” (Appeal Brief, p. 7), and the Examiner once again fails to provide any specific equivalence between each claimed element and a corresponding element of the prior art in the Examiner’s Answer, which renders the Examiner’s discussions in the Examiner’s Answer entirely unintelligible and amorphous. In addition, directly as a result of the Examiner’s failure to specifically identify the equivalence between each claimed element and a corresponding element of the prior art, Applicant had to resort to guessing at the Examiner’s intended interpretation (see, e.g., Appeal Brief). In view of the Examiner’s failure to specifically identify the equivalence between each claimed element and a corresponding element of the prior art in support of the rejection, Applicant submits that the Examiner has failed to establish *prima facie* cases of rejections for the pending claims. In any case, Applicant submits that the actual teachings of the applied references do not support the rejections, for at least the reasons stated below.

First, with respect to the claimed limitation of claim 37 that “at the capturing device, receiving a request from a user to access the exchanged data [exchanged between the data memory of the capturing device and the at least one recording device],” the Examiner does not specifically identify which elements of Nagaya actually corresponds to the claimed “capturing device,” “a user,” “capturing device” or “recording device.” Although the Examiner summarily states that col. 7, l. 2-16 and 39-47; and col. 15, l. 17-23 of Nagaya discloses the feature that “at the capturing device, receiving a request from a user to access the exchanged data [exchanged between the data memory of the capturing device and the at least one recording device],” (see, e.g., Examiner’s Answer, p. 32-33), none of the

cited sections of Nagaya (as well as the remaining sections of Nagaya) actually suggests anything about generating “**a request from a user to access the exchanged data** [exchanged between the data memory of the capturing device and the at least one recording device],” let alone that such **a request is actually received “at the capturing device.”** Based on the Examiner’s discussion on p. 32-33 of the Examiner’s Answer, it appears the Examiner is implicitly contending that if “**the exchanged data** [exchanged between the data memory of the capturing device and the at least one recording device]” is transmitted to a third party location, then “**a request from a user to access the exchanged data**” is inherently present. However, there is no logical or technical basis for this implicit contention, since a transmission of data need not be conditioned on **an explicit request from a user.**

On p. 34 of the Examiner’s Answer, the Examiner noted that “it is unclear as to which specific section of claim 37 Applicant is referring” in the statement made on p. 8 of the Appeal Brief, i.e., “the user request for data discussed in Nagaya is absolutely not conditioned on whether or not any data has been exchanged between the data memory of the capturing device and the at least one recording device.” Applicant’s argument is that to the extent any Nagaya suggests any explicit “user request for data,” such “user request” does not specifically relate to “data [which] has been exchanged between the data memory of the capturing device and the at least one recording device.”

Independent of the above, the Examiner attempts to apply an arbitrarily broad interpretation to the claimed limitation that “responsive to the request, **retrieving the exchanged data stored on the virtual data memory** [formed for the capturing device by **operational association** between **the data memory of the capturing device and the at least one recording device**], the **retrieving occurring at the capturing device**,” mainly based on the assertion that “virtual memory” and “operational association” are not defined in any significant detail. However, the Examiner’s arbitrarily broad interpretation is clearly contrary to the established law governing claim interpretation. It is a fundamental rule of claim interpretation that the claims should be given “the broadest reasonable interpretation” that is consistent with the specification. (See M.P.E.P. 2111, citing Phillips v. AWH Corp., 415 F.3d 1303 (Fed. Cir. 2005), and In re Hyatt, 211 F.3d 1367 (Fed. Cir. 2000)). Contrary

to the Examiner's assertion, the present specification unequivocally defines how "virtual memory" is achieved:

Data memory 28 of capturing device 14 has a certain capacity 52. Data memory or memories 30 of recording device 18 has/have a very much larger capacity. Now, it is provided, according to the present invention, that data memory 28 and data memory 30 are connected. This is described, for example, in the light of a connection via digital network 16. Thereby, the reading out of data from data memory 28 for transmission of these data on digital network 16 may be logically interconnected to the input of new data into data memory 28. **Because of this interconnection, a virtual data memory is made available** to video server 24 (or, in the case of capturing device 12, to digital camera 20), **whose capacity is greater than the physical capacity of data memory 28 (or 26).** (Substitute Spec., p. 17, l. 5-17).

A data memory 64 of capturing device 60 has a certain recording capacity, such as 24 hours (indicated in Figure 8 by the upper bar).

**A recording device 66 having a data memory 68 which has a considerably greater capacity than data memory 64, is used as a recording server for the data made available by capturing device 60 via digital network 16. A virtual data memory, as described above, is formed for capturing device 60 by this data memory 68,** whereby the capacity limitations of data memory 64 may be increased.

....

If a certain capacity level in data memory 64 is exceeded, that is, when, for example, (as indicated in Figure 8) 50% of storage capacity has been reached, then data are "transferred to an external location", by transmitting them to **recording device 66 and storing them in its data memory 68. The virtual memory formed for capturing device 60 is indicated by connection 72.** (Substitute Spec., p. 21, l. 7-32).

When viewed in light of the unequivocal explanation found in the above-quoted sections of the specification, the meaning of "a virtual data memory is formed for the capturing device by operational association between the data memory of the capturing device and the at least one recording device" is absolutely clear, i.e., the data memory for the capturing device and the data memory for the recording device are operationally connected to

form the “virtual data memory” which is available for storage use by the capturing device. In light of this unambiguous interpretation, the Examiner’s asserted interpretation on p. 35 of the Examiner’s Answer, i.e., transferring of packets between DVCT 1 and MISS 3 reads on the claimed “virtual data memory” limitation, is clearly erroneous. To the extent the Examiner argues on p. 36 that **“all that is required** to form a ‘virtual memory’ **is that two separate memories are connected,**” a mere connection between two memories is clearly insufficient; instead, the claimed “virtual data memory” is **the total data memory capacity formed by connection between the data memory of the capturing device and the data memory of the recording device, which “virtual data memory” is available for data storage by the capturing device.** To the extent the Examiner cites the connection configuration shown in Figs. 1 and 2, there is no suggestion that the memory of recording apparatus 100 is operationally connected to the memory of computer 220 in such a way that the memory of computer 220 is available for data storage use by the recording apparatus 100.

Since there is no suggestion in Nagaya regarding any virtual memory formed by operational association between the recording/playback apparatus 100 and the personal computer 220, Nagaya clearly cannot suggest the claimed limitation “responsive to the request, **retrieving the exchanged data stored on the virtual data memory, the retrieving occurring at the capturing device.**”

For at least the foregoing reasons, the combination of Shimizu and Nagaya fails to render obvious independent claims 37, 64 and 72, as well as dependent claims 38-48, 65, 66 and 68-71. Reversal of the obviousness rejection is respectfully requested.

**B. Rejection of Claims 49, 51-63 and 67 under 35 U.S.C. § 103(a)**

Claims 49, 51-63 and 67 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shimizu in view of Nagaya and U.S. Patent No. 5,724,475 (“Kirsten”). Since no new substantive arguments and/or contentions were presented in the Examiner’s Answer in connection with this rejection, Applicant respectfully submits that the pending claims 49, 51-63 and 67 are patentable over the applied references for at least the reasons presented in the

Appeal Brief. Reversal of the obviousness rejection of claims 49, 51-63 and 67 is respectfully requested.

**C. Rejection of Claim 50 under 35 U.S.C. § 103(a)**

Claim 50 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Shimizu in view of Nagaya, Kirsten and U.S. Patent No. 6,954,859 ("Simerly"). Since no new substantive arguments and/or contentions were presented in the Examiner's Answer in connection with this rejection, Applicant respectfully submits that the pending claim 50 is patentable over the applied references for at least the reasons presented in the Appeal Brief. Reversal of the obviousness rejection of claim 50 is respectfully requested.

**CONCLUSION**

For the foregoing reasons, it is respectfully submitted that the final rejections of claims 37-72 should be reversed.

Respectfully submitted,

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